UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EX PARTE OLIVER *ET AL.*

U.S. PATENT APPLICATION NUMBER 10/650,487

FILING DATE: AUGUST 27, 2003

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

LEWIS AND ROCA *LLP*
2440 W. EL CAMINO REAL, 6TH FLOOR
MOUNTAIN VIEW, CA 94040
T: 650.391.1380
F: 650.391.1395

ATTORNEY FOR THE APPELLANTS
AND REAL-PARTY-IN-INTEREST

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

In accordance with 37 C.F.R. § 41.52, the Appellants respectfully request rehearing and reconsideration of the decision rendered by the Board of Patent Appeals and Interferences on August 12, 2011 (BOARD DECISION).

The Appellants contend that the BOARD DECISION evidences that the Board overlooked or misapprehended several particular points, which ultimately lead to an incorrect finding of obviousness of the presently claimed invention and affirmation of the Examiner's rejections during prosecution. These points are identified and addressed herein.

An overlap of ranges is absent as *Chasin* does not teach the claimed range of 'less than one percent'

The Board's decision makes erroneous findings of fact concerning the *Chasin* reference (U.S. patent publication number 2003/0204569). The Board's erroneous findings are believed to have contributed to a subsequent erroneous determination as to obviousness under 35 U.S.C. § 103(a). The Appellants believe that such error warrants the Board's reconsideration of the present appeal.

Each of the independent claims recites a reliable classifier with 'a probability of erroneous classification' of '**less than one percent**.' Independent claim 1 is provided below as an example:

> A method for improving a statistical message classifier, comprising:
>
> testing a message with a machine classifier, wherein the machine classifier is capable of making a classification of the message and the machine classifier is a reliable classifier having a probability of erroneous classification of less than one percent; and
>
> updating the statistical classifier according to the classification made by the machine classifier, wherein the statistical classifier is configured to detect an unsolicited message and comprises a knowledge base that tracks the spam probability of features in classified messages.

The Board contends that *Chasin* discloses "no or few false positives" and a "confidence ratio approaching 100 percent," which is purportedly equivalent to the claimed range of 'less than one percent.' See BOARD DECISION , 4. The Appellants maintain that notwithstanding *Chasin*'s assertion that a "confidence ratio" "can be increased to **a relatively high value**, e.g., **approaching 100 percent,**" *Chasin* does not teach the claimed 'less than one percent' range. A "relatively high value" "approaching 100 percent" **lacks sufficient specificity** to constitute the requisite disclosure of the claimed range. See MPEP § 2131.03(II); *Atofina v. Great Lakes Chem Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006). *Chasin* does not explicitly or necessarily teach or suggest that a confidence ratio or level results in an erroneous classification in the 'less than one percent' range.

Although, *Chasin* discloses "a confidence level of 90 to 95 percent or higher," such confidence level is merely given as an example of a confidence level that a user might desire with respect to a user provided "minimum acceptable score." See *Chasin*, [0052], FIG. 4. *Chasin* is completely silent with respect to a 'less than one percent' range. *Chasin* also fails to teach *how* a "confidence level of 90 to 95 percent or higher" actually functions in the 'less than one percent' range or limits the number of false positives. If *Chasin* were capable of functioning in the 'less than one percent' range, then *Chasin* would have stated the same. The Appellants contend that *Chasin's* failure to disclose the claimed range suggests that *Chasin* could not operate within that range. Mere naming or description of desirous subject matter is insufficient. C.f. *Elan Pharm., Inc. v.*

Mayo Found. For Med. Educ. & Research, 346 F.3d 1051, 1054 (Fed. Cir. 2003). The teaching of a "confidence level" "approaching 100 percent" or "confidence level of 90 to 95 percent or higher," in *Chasin* fails to teach the claimed range of 'less than one percent.' As such, an overlap in ranges between *Chasin* and the presently claimed invention is absent.

The Board misapplies Chasin with respect to "no or few false positives.

The Appellants contend that the Board misapplies *Chasin* with respect to "no or few false positives." The Appellants submit that *Chasin* does NOT teach "**no or few false positives**" in paragraphs [0007], [0011] (or any where else in *Chasin)* notwithstanding an indication to the contrary by the Board. See BOARD DECISION, 4. Paragraph [0007], which is part of the "Relevant Background" section of *Chasin*, only describes *the general state of the art*. *Chasin* recites that "there is a need for a method of accurately identifying and filtering unwanted junk mail e-mail messages or spam that also creates no or few false positives." *Chasin*, [0007]. Merely citing *a need* for creating no or few false positives is not equivalent to *Chasin actually teaching* a method creating no or few false positives. At best, *Chasin* describes the ability to "limit the number of false positives." See *Chasin*, [0011], [0050], and [0052]. Yet limiting the number of false positives does not necessarily teach or equate to "few false positives" or zero false positives. As such, the Appellants believe that the Board's conclusion that the disclosure of "no or few false positive" in *Chasin* anticipates the claimed range is erroneous.

The criticality of the claimed 'less than one percent' range rebuts a prima facie case of obviousness

A *prima facie* case of obviousness based on overlapping ranges can be rebutted by a showing of the criticality of the claimed range. See MPEP § 2144.05(III) (citing *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990)). *Chasin* -- the very reference cited by the Examiner -- addresses the various deficiencies of existing spam filters and classification engines and describes the need in the art for a method of identifying and filtering junk e- mail messages to create no or few false positives." (see *Chasin* [0009]; see also [0007]). The Appellants' claimed invention succeeds where *Chasin* ultimately fails.

The claimed 'less than one percent' is a critical range as it addresses the deficiencies of existing filters and classification engines. This is supported by *Chasin,* which emphasized the need in the art to create "no or few false positives." Given the criticality of claimed range of 'less than one percent,' one would expect *Chasin* to explicitly disclose the same if it could, but *Chasin* does not because it cannot. As such, the claimed range of 'less than one percent' achieves a result that that is not disclosed in *Chasin.* A *prima facie* case of obviousness based on overlapping ranges in *Chasin* can therefore be rebutted.

CONCLUSION AND REQUESTED RELIEF

The Appellants believe that the Board incorrectly affirmed the Examiner's rejections based on obviousness as an overlap in ranges between the prior art and the presently claimed invention is absent. *Chasin's* teaching of a "confidence level" "approaching 100 percent" or a "confidence level of 90 to 95 percent or higher," lacked sufficient specificity to constitute an anticipation of the claimed 'less than one percent' range. Further, *Chasin's* disclosure of "no or few false positives" also failed to anticipate the claimed range. A *prima facie* case of obviousness could also be rebutted by the Appellants' showing that the claimed 'less than one percent' range is a critical range that was not disclosed in the prior art. Reconsideration of the previously rendered BOARD DECISION is respectfully requested.

Respectfully submitted,
Jonathan J. Oliver et al.

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By: /laurierose lubiano/

Laurie Rose Lubiano (Reg. No. 67,784)
LEWIS AND ROCA *LLP*
2440 W. El Camino Real, 6th Floor
Mountain View, CA 94040
T: 650.391.1380
F: 650.391.1395

ATTORNEY FOR THE APPELLANTS
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